

Application No.: 09/990,327

Docket No.: 05525-00003-US

AMENDMENTS TO THE CLAIMS

- Claim 99 The method as recited in claim 9 wherein the wireless device is a telephone.
- Claim 100 The method as recited in claim 17 wherein the wireless device is a telephone.
- Claim 101 The method as recited in claim 26 wherein the wireless device is a telephone.
- Claim 102 The method as recited in claim 35 wherein the wireless device is a telephone.
- 21 Claim 103 The method as recited in claim 44 wherein the wireless device is a telephone.
- Claim 104 The method as recited in claim 53 wherein the wireless device is a telephone.
- Claim 105 The method as recited in claim 54 wherein the wireless device is a telephone.
- Claim 106 The method as recited in claim 62 wherein the wireless device is a telephone.
- Claim 107 The method as recited in claim 71 wherein the wireless device is a telephone.
- Claim 108 The method as recited in claim 80 wherein the wireless device is a telephone.
- Claim 109 The method as recited in claim 89 wherein the wireless device is a telephone.
- Claim 110 The method as recited in claim 98 wherein the wireless device is a telephone.

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REMARKS

This response adds new Claims 99-110, all of which are dependent. In addition, an IDS attached hereto, brings some prior art to the attention of the Examiner.

The Office Action acted on all 98 claims in the application. The Action indicated that Claims 1-8 were allowed, and that allowance is acknowledged. Claims 9-98 were rejected. The Office acknowledged a claim for priority in the application under 35 USC 120; this reissue application for U.S. patent 5,991,749 (issued on an application filed September 9, 1997) claimed priority from a provisional application of September 11, 1996.

All claims were rejected under 35 USC § 103, with respect to Hassett, the other references cited in the Action were cited of interest.

As reflected in the MPEP Section 706.02(j) three criteria are required in order to establish a prima facie case of obviousness (the basis for all the rejections in this application). One of those criteria is that "the prior art reference must teach or suggest all the claim limitations." (emphasis added). As will be detailed below, applicant believes the rejection of Claims 9-98 is flawed in that the prior art reference relied on neither teaches nor suggests all of the claim limitations. Accordingly, in the absence of a prima facie case of obviousness, applicant submits that the rejected claims (9-98) clearly and patentably define over the prior art relied on. Furthermore, inasmuch as the new claims 99-110 added by this amendment depend either directly or indirectly on claims 9-98, those new claims are patentable on the same basis as are claims 9-98. In view of all the foregoing, reconsideration of the rejected claims 9-98 and allowance of this application, including all claims 1-110 are solicited.

This application is entitled "Wireless Telephony for Collecting Tolls, Conducting Financial Transactions, and Authorizing Other Activities." As indicated in the background, the invention "relates to methods of using a cellular phone or other wireless communication device" to implement certain transactions and/or activities. In connection with implementing financial transactions, the application describes how funds can be transferred from one account to another.

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This can provide for the purchase of a good or service (See example 1), or payment of a parking fee (See example 2) or the payment of transit fares (See example 3), the collection of highway tolls (under the heading of "Cell phone Tolling Procedure"), or providing transaction security for purchases made by the internet (under the heading "Personal Computer Transaction Authentication/Security Procedure and PC/Cell phone Interface Device Description).

The rejected claims include independent Claim 9 (directed to a method for transferring funds between different accounts), 17 (directed to a method for realizing a payment transaction to pay for goods or services), 26 (directed to a method realizing a payment for highway toll), 35 (directed to a method realizing a payment for a public transit fare), 44 (directed to a method realizing a payment for parking garage fee); 53 (directed to a method realizing an account inquiry transaction), 54 (directed to a method transfer funds between different accounts), 62 (directed to a method realizing a payment for goods or services), 71 (directed to a method realizing a payment for a highway toll), 80 (directed to a method realizing a payment for public transit fare), 89 (directed to a method realizing a payment for a parking garage fee), and 98 (directed to a method realizing an account inquiry transaction).

The Action contains a rejection of these claims as obvious over Hassett. Hassett describes an electronic vehicle toll collection system and method which uses a wireless transponder on board a vehicle. Hassett describes two or three different events or transactions. In a first event, In Vehicle Component (IVC) 16 is removed from a vehicle and physically connected to a cash terminal 17 (See figure 8), so that the IVC 16 can be credited or loaded with the toll amount the motorist wishes to prepay. An agent enters into the cash terminal 17 that monetary value and the cash terminal 17 transmits a signal to the IVC 16. The cash terminal may also print a receipt which both verifies the amount of the credit and identifies all toll transactions involving the IVC 16 since a previous cash transaction. (See col. 24, lines 3-23).

According to this description, a transaction ensues between a motorist or user and the toll agency. That transaction involves transferring cash or an authorization to charge a credit card. The cash is physically conveyed to the agent or the credit card authorization authorizes the transfer of the motorist's selected amount from the motorist's account to the account of the

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agency involved in toll collection. The IVC 16 does not take part in this transaction. Rather, data is written to the IVC which indicates the value transferred in the transaction.

The patent also describes a second event in which the amount stored in the IVC will be decremented to correspond to the amount of a toll (See col. 13, lines 33-44). At the same time that the quantity stored in the IVC 16 is debited, the motorist or user receives a proceed signal from the IVC 16. Note that in this event there is no transfer of funds between different accounts nor is there any payment. Rather, the only transfer of funds has already occurred, and likewise the payment has occurred in connection with the transaction associated with the equipment illustrated in Figure 8. As has been indicated, the IVC 16 is merely a witness to that transaction.

Finally, the reference also describes a third event which is triggered as a vehicle carrying the IVC 16 approaches a toll facility, when the amount of the toll would reduce the credit balance in the IVC below some preset threshold. If that is the case, the processor 50 "tops up" the balance in the IVC and also sets an account incremented flag (See col. 27, lines 60-65). This action triggers the generation of a financial transaction record due to the incrementing operation (See col. 29, lines 10-15). That financial transaction record is then "used at that time or later to update the central account records and produce a record of the amount of the increment that is billed to the creditor account (bank, credit card or telephone billing account) which has been previously designated and authorized by the user" (col. 29, lines 14-19). Here the IVC 16 acts to trigger an event but plays no other part in any related transaction.

To summarize, in the first event, the IVC 16 is physically connected to a cash terminal and data is transferred representing a transaction taking place between the user and the toll collection agency. That transaction does not operate with a transmission from a wireless device. A second event is the debiting of the data in the IVC 16 as a vehicle which carries the IVC 16 passes a toll collection facility. Even if this were considered a transaction, there are no accounts involved since the only action which is involved is the debiting of the data in the IVC 16. Finally, the IVC 16 may exchange information (particularly the account incremented data) with the roadside equipment. That event triggers the creation of a financial record which can be used either at that time or a later time to actually implement a financial transaction between two

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different accounts. While the wireless device does transmit data which triggers a transaction, it does itself, take part in that transaction.

Hassett then is significantly different from the subject matter of the rejected claims.

Claim 9 is directed at a method of using a wireless device to transfer funds between accounts. The Action acknowledges that the reference is directed at collection of vehicle tolls but alleges (1) that the claimed transactions are common and (2) the type of transaction does not affect the method steps and concludes that the claimed method would have been obvious. The first conclusion is irrelevant to the question of obviousness. The second conclusion can only be made by ignoring the words of the claim - not a proper technique of claim construction. As the CAFC said in In re Sabatino, 480 F.2d 911, 913, 178 USPQ 357, 358 (CCPA 1973) "Claim limitations defining the subject matter of the invention are never disregarded." It is well settled that the claim must be construed in the broadest **reasonable** manner, consistent with the specification.

The Action ignores the fact that the only transfer of funds which is disclosed in the reference is the transfer of funds from the user to the toll agency which is effected by the use of the equipment shown in fig. 8 - and that equipment does **not** use any wireless device. Indeed it could be argued that the reference teaches away from the claimed invention since it does **not** use a wireless device for funds transfer.

Neither the Office Action nor the reference responds to the first clause of Claim 9, e.g., *responding to the activation or clearing of the wireless device allowing it to engage in funds transfer*. In connection with the second recitation of Claim 9, the Office Action suggests that the subject matter appearing at col. 5, lines 23-26 and col. 20, lines 40-42 corresponds to the clause of Claim 9 which recites *responding to identification of the user by receiving wireless device identification information transmitted by the wireless device*. At col. 5, lines 23-26, the reference describes that a vehicle identification number is transmitted. The vehicle ID is not the *wireless device identification* which is called for in the Claim. Likewise, at col. 20, lines 40-42, the

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reference indicates that a vehicle identifier is transmitted – applicant represents that the vehicle identifier is not *the wireless device identification information* which is called for in the claim.

Claim 9 then calls for *entering a function code which identifies the desired funds transfer on the keypad of the wireless device*. The Office Action refers to col. 8, lines 54-67 as describing entering a function code which identifies the desired transaction. Applicant disagrees with this conclusion. The reference indicates that the transponder 228 includes a user-interface section 283 which includes “user operable keys 282.” The keys 282 may be used to “enter any information that may be required.” To the extent that the Office Action asserts the reference teaches entering a function code which identifies a desired transaction, the Office Action is not based on the reference. In fact, the reference contains not one indication of what information might be required and entered by the user operable keys 282. Applicant disputes that the reference has any teaching of entering a function code and Applicant asserts that there is no subject matter in the reference relating to the *entering a function code which identifies the desired funds transfer on the keypad of the wireless device* as recited in Claim 9.

Neither the reference nor the Office Action refers to *sending the function code to a central processing unit*.

In conclusion, the Action ignores the fact that the reference teaches away from the invention in that it does **not** use a wireless device to transfer funds between accounts. Neither the Office Action nor the reference reaches the first recitation of the claim, e.g. *responding to the activation or clearing of the wireless device allowing it to engage in funds transfer*. While the Office Action alleges that the reference has some subject matter corresponding to the *responding to identification of the user by receiving wireless device identification information transmitted by the wireless device*, in fact the reference describes transmitting the vehicle identification information not the subject matter actually recited in the claim. The Office Action does not refer to, and the reference does not teach the subject of *entering a function code which identifies the desired funds transfer on the keypad of the wireless device* recitation. The Office Action refers to entering function code information; but that allegation is not supported by the reference which describes the presence of keys, but not their function or purpose. Neither the Office Action nor

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the reference refer to the *sending the function code to a central processing unit* recitation. For each of these reasons, Applicant submits that Claim 9 distinguishes from the reference.

Claim 17 is directed at realizing a payment transaction where a user, with a wireless device, pays a vendor for goods or services. The Action acknowledges that the reference is directed at collecting vehicle tolls but alleges (1) that the claimed transactions are common and (2) the type of transaction does not affect the method steps and concludes that the claimed method would have been obvious. The first conclusion is irrelevant to the question of obviousness. The second conclusion can only be made by ignoring the words of the claim - not a proper technique of claim construction. It is well settled that the claim must be construed in the broadest **reasonable** manner, consistent with the specification.

Applicant asserts that neither the Office Action nor the reference deals with the *responding to the clearing or activation of the wireless device allowing it to engage in the payment transaction* subject matter of Claim 17. The Office Action alleges that the reference teaches "sending/receiving wireless device identification information" and presumably this subject matter bears on the second clause of Claim 17, e.g., *responding to identification of the user by receiving wireless device identification information transmitted by the wireless device*. In point of fact, however, what the reference describes is transmitting vehicle identification information. Accordingly, the reference does not describe the subject matter actually found in the claim.

Neither the Office Action nor the reference deals with the third clause of Claim 17, e.g., *receiving, at the wireless device, an instruction relating to the payment transaction*. The Office Action refers to entering a function code, but as has already been noted, that subject matter is not supported by the reference which merely describes the presence of one or more keys in a user interface.

Claim 17 also calls for *sending payment transaction instruction information to a central processing unit to identify the payment transaction*. The subject matter is not referred to in the Office Action. Claim 17 concludes by calling for *authorizing, using the central processing unit,*

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*the payment transaction, and confirming completion of the transaction.* The Office Action refers to "authorizing the transaction" presumably supported in the reference at col. 14, lines 65-67 and col. 28, lines 12-23. However, col. 14, lines 65-67 the reference indicates that at times, the IVC will generate a perceptible proceed message. It is true, that the IVC includes a central processing unit. However, this central processing unit does not authorize a payment transaction and if it is indeed the central processing unit which is relied on in the rejection there is no subject matter corresponding to the *sending payment transaction instruction information to a central processing unit to identify the payment transaction* as is also called for in Claim 17.

For these reasons, Applicant submits that Claim 17 patentably defines over the reference.

Claim 26 is directed at a method of realizing a payment transaction for paying a highway toll. While the reference is directed at toll collection it is not directed at using a wireless device to realize *a payment transaction*. The reference teaches a transaction, using the equipment of fig. 8 to transfer funds or credit to a toll agency - this transaction is **not realized using a wireless device**. The IVC 16, which is a wireless device, is only a witness to the transaction by having recorded therein the amount of the transaction. Like the other claims already discussed, neither the Office Action nor the reference mentions the first clause of the claim, e.g., *responding to the clearing or activation of a wireless device allowing it to engage in the toll payment transaction*. While the Office Action refers to identification, contrary to the implied assertion in the Office Action (the subject matter cited in cols. 5 and 20) nothing in the reference supports the assertion that the reference teaches sending/receiving wireless device identification information. In point of fact the reference does not. The reference describes sending a vehicle identification information. The Office Action does not expressly refer to the *receiving, at the wireless device, an instruction relating to the highway toll payment transaction* although it appears that the assertion of entering a function code may be thought to be related to this recitation. In point of fact, it is not because the Office Action is not supported by the reference. The reference describes the presence of a user interface including a key or keys. However, the presence of a key does not teach the step of *receiving, at the wireless device, an instruction relating to the highway toll payment transaction* which is what is actually recited in the claim. The claim continues and calls for *sending highway toll payment instruction information to a central*



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*processing unit to identify the highway toll payment transaction.* Neither the Office Action nor the reference describes *sending highway toll payment instruction information to a central processing unit to identify the highway toll payment transaction*, as recited. The Claim also calls for *authorizing, using the central processing unit, the highway toll payment transaction*. The Office Action does refer to authorizing a transaction, but that authorization does not use *the central processing unit to which is sent the highway toll payment instruction information* as is recited in the Claim. For these reasons, the Applicant submits that Claim 26 patentably defines over the art relied on.

Claim 35 is directed at a method of realizing a payment transaction allowing a user, operating a wireless device, to pay a public transit fare. Like the other claims that have been discussed, neither the Office Action nor the reference refers to *responding to the activation or clearing of a wireless device allowing it to engage in the transit fare payment transaction* as recited in Claim 35. Claim 35 distinguishes in the *responding to identification of the user...wireless device* recitation as does each of the other claims already discussed. Claim 35 distinguishes from the rejection by calling for *receiving at the wireless device an instruction relating to the transit fare payment transaction*. The Claim also distinguishes from the Office Action and the reference by calling for *sending transit fare payment instruction information to a central processing unit....* Again, the Claim distinguishes from the statement of the rejection as well as the reference by calling for *authorizing, using the central processing unit, the transit fare payment transaction*. For these reasons, Applicant submits that Claim 35 patentably defines over the cited art.

Claim 54 is directed to a method of allowing a user of a wireless device to transfer funds between different accounts. The Action ignores the fact that the only transfer of funds which is disclosed in the reference is the transfer of funds from the user to the toll agency which is effected by the use of the equipment shown in fig. 8 - and that equipment does **not** use any wireless device. Indeed it could be argued that the reference teaches away from the claimed invention since it does **not** use a wireless device for funds transfer. The first step of the method, *responding to the activation or clearing of the wireless device to allow it to engage in the funds*

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*transfer*, is not mentioned in the Office Action nor does it bear any resemblance to any disclosure in the reference.

The second clause of Claim 54, *responding to identification of the user by receipt of wireless device identification information*, also finds no counterpart in the reference. The Office Action suggests that the reference is pertinent at col. 5, lines 23-26 and col. 20, lines 40-42. However, at this passage, the reference describes sending vehicle identification information. Applicant asserts that the vehicle identification information has no connection to the *wireless device identification information* which is the subject matter of this clause of Claim 54.

The next clause of the claim is not commented on in the Office Action and finds no counterpart in the reference, that is, *receiving from the wireless device identification of a function corresponding to funds transfer*. Presumably, the Office Action intends the function code or instruction code assertion to be connected to this clause of this claim. However, as explained elsewhere, the reference does not teach the use of any function code or instruction code. Rather, the reference indicates that the device includes a user interface with one or more keys. Whether those keys would be used to enter a function code or an instruction code is pure speculation since there is neither a teaching nor suggestion bearing on that subject in the reference.

The next clause of the claim calls for *operating on the funds transfer function at a central processing unit*. Neither the Office Action nor the reference bears on this subject matter of the claim.

Applicant asserts that Claim 54 patentably differs from the reference relied on for at least the foregoing reasons.

Claim 62 is directed at a method of realizing *a payment transaction by a user operating a wireless device paying a vendor for goods or services*. The first clause of the claim, *responding to the activation or clearing of the wireless device to allow it to engage in the payment transaction*, is not commented on in the Action and bears no connection to the reference.

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The second clause of the claim, *responding to identification of the user by receipt of wireless device identification information*, also finds no counterpart in the reference. Applicant believes that the reference to col. 5, lines 23-26 and col. 20, lines 40-42 is intended to suggest that at these cited portions of the reference, the reference describes the subject matter of the claim. To the contrary, as has been explained in connection with other claims, at the cited portions of text, the reference describes sending a vehicle identification data. Applicant asserts that the *wireless device identification information* is not vehicle identification data and has no connection therewith.

The next clause of the claim, *receiving from the wireless device, an instruction relating to the payment transaction*, also bears no connection to the reference and is not commented on in the Office Action.

For the foregoing reasons, Applicant asserts that Claim 62 patentably defines over the cited art.

Claim 71 is directed at a *method allowing the realization of a payment transaction allowing the user, operating a wireless device, to pay a highway toll*. The first recitation in the claim, *responding to activation or clearing of the wireless device to allow it to engage in the toll payment transaction*, is not discussed in either the Office Action or the reference.

The next clause of the Claim deals with identification. As has been noted, the Action refers to the transmission of vehicle identification information. Applicant has asserted before and again asserts here, that the transmission of vehicle identification information is not the *identification of the user by receipt of wireless device identification information* which is claimed here.

The next clauses of the Claim, *receiving, from the wireless device, an instruction relating to the highway toll payment transaction, and sending highway toll payment instruction information to a central processing unit to identify the highway toll payment transaction* are neither commented on in the Action nor find any counterpart in the reference.

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The Office Action does comment on an authorizing step, although not the subject matter actually found in this Claim, which is *authorizing, using the central processing unit, the highway toll payment transaction*. Rather, the allegation that the reference teaches authorizing the transaction refers to the proceed command emitted by the IVC (found at col. 14) and the authorization (by the user) given to the toll agency. In neither case does the subject matter correspond to the claimed subject matter which refers to authorization effected by "the central processing unit" which is the recipient of the *highway toll payment instruction information*.

For the foregoing reasons, Applicant asserts that Claim 71 patentably defines from the reference.

Claim 80 is directed at a *method allowing the utilization of a payment transaction allowing a user, operating a wireless device, to pay a public transit fare*. The Office Action does not comment on the first clause of the claim, e.g., *responding to the activation or clearing of a wireless device to allow it to engage in the transit fare payment transaction*.

The Office Action does refer to transmission of identification information, but whereas the Claim is specific to *identification of the user by receipt of wireless device identification information*, the reference refers to transmission of vehicle identification. Applicant asserts that there is no correlation between the user's identification by *wireless device identification information* and any vehicle identification.

The next two clauses of the Claim, *receiving, from the wireless device, an instruction relating to the transit fare payment transaction, and sending transit fare payment instruction information to a central processing unit to identify the transit fare payment transaction* are not referred to in the Office Action nor do they correspond the subject matter of the reference. Finally, the last clause of the Claim distinguishes from the reference and the comments in the Office Action in exactly the same way that the authorizing step of Claim 71 distinguishes from the reference.

Applicant asserts that Claim 80 patentably defines over the cited art for the foregoing reasons.

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Claim 89 is directed at a *method allowing the realization of a payment transaction allowing the user, operating a wireless device, to pay a parking garage fee*. The first clause of the Claim is not commented on in the action nor does it have any apparent connection with the reference.

The second clause of the Claim relating to identification distinguishes from the art. The Office Action attempts to draw parallel between the transmission of vehicle identification information by the wireless device in the reference and the step of *responding to the identification of the user by receipt of wireless device identification information* found in the Claim.

The next two clauses of the Claim, *receiving from the wireless device, an instruction identifying the parking garage fee transaction, and sending parking garage fee payment instruction information to a central processing unit to identify the parking garage fee payment transaction* are not commented on in the Action nor do they find any counterpart in the reference. Finally, the last clause of the claim distinguishes from the reference and the Office Action in exactly the same way the last clause of Claims 71 and 80 distinguish from the reference.

Claim 98 is directed at a *method allowing the realization of an account inquiry transaction allowing a user, operating a wireless device, to obtain account balance information*. The first and last clauses of Claim 98 differ from both the Action and the reference in exactly the same way as has been pointed out with respect to Claim 89. The distinction between the identification clause of Claim 98 and the Action and the reference has already been pointed out in connection with other claims.

The remaining clauses of the Claim, *receiving, from the wireless device, an account inquiry instruction identifying the account inquiry transaction, and sending account inquiry instruction information to a central processing unit to identify the account inquiry transaction* are neither commented on in the Action nor find any counterpart in the reference.

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For the foregoing reasons, Applicant submits that Claim 98 patentably distinguishes from the cited art. Dependent claims 11, 19, 28, 37, 46, 56, 64, 73, 82 and 91 recite *using the wireless device to identify the variable amount, and sending the identified amount to the central processing unit*. The Action notes that the reference accommodates variable tolls. The Action further asserts that the wireless device (IVC 16) identifies the variable amount of the toll and transmits to the central processing unit, citing col. 14, lines 12-15. The cited portion of the reference merely says that the subject matter of the reference accommodates "progressive toll roadways". Applicant disputes that the reference describes any transmission of an identified amount from the IVC 16 to any central processing unit and asserts each of these claims is patentable for this additional reason.

Dependent claims 13, 22, 31, 40, 49, 58, 67, 76, 85 and 94 recite *determining a destination account from the function code*. The Action asserts that the reference discloses that a destination account is identified by the function code information citing col. 28, lines 12-33. This portion of the reference describes how the user provides to the toll agency account identification to be charged when the amount of the initial transaction is depleted. There is no mention or hint in this passage (or any other passage in the reference) that a function code (which also has no counterpart in the reference) can be used to identify a destination account. For this reason applicant asserts each of these claims patentably distinguishes from the reference.

Dependent claims 14, 23, 32, 41, 50, 59, 68, 77, 86 and 95 recite *identifying an account using a keypad of the wireless device*. The Action asserts that the reference discloses using a keypad of the wireless device to enter information, citing col. 15, line 61 to col.16, line 3. Applicant notes that the Action fails to assert that the reference discloses what is claimed. For the reason that the Action admits, by inference, that the reference does not describe *identifying an account using a keypad of the wireless device*. Applicant asserts these claims are patentable.

The Action notes that the claims 1-8 were allowed because the art failed to show identifying the user's account and completing the transaction based on the identification number of the cellular phone which is automatically transmitted. Applicant notes that each of the rejected claims describes transaction processing which either calls for *responding to*